UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/936,344	09/24/97	EMBREE	P 080398.P115

LM02/0621

BLAKELY SOKOLOFF TAYLOR AND ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES CA 90025

EXAMINER	
LEE, P	
ART UNIT	**PAPER NUMBER**
2747	9

DATE MAILED: 06/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/936,344	Embree et al
Examiner	**Group Art Unit**
Ping Lee	2747

☒ Responsive to communication(s) filed on *Mar 31, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-15* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-15* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 3/31/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/936,344 is acceptable and a CPA has been established. An action on the CPA follows.

Drawings

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

3. The substitute abstract of the disclosure filed on 9/7/99 has not been entered because it was not submitted on a separate sheet. Correction is required. See MPEP § 608.01(b).

4. The abstract of the disclosure is still objected to because of the inclusion of legal phraseologies such as "discloses" and "comprises" in lines 1 and 3, respectively. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, "a plurality of memory banks of semiconductor memory devices" raises the issue of new matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Upon deletion of the new matter as stated in Section 6 above, claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Vizireanu et al (5,625,570) for the same reasons as set forth in Section 2 of the last office action, paper number 5, dated 12/1/99.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Upon deletion of the new matter as stated in Section 6 above, claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vizireanu et al for the same reasons as set forth in Section 4 of the last office action, paper number 5, dated 12/1/99.

11. Upon deletion of the new matter as stated in Section 6 above, claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vizireanu et al in view of Schaus et al (5,273,050) for the same reasons as set forth in Section 5 of the last office action, paper number 5, dated 12/1/99.

12. Assuming Applicant's newly amended feature does not raise the issue of new matter, claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vizireanu et al.

Although Vizireanu et al differs from the present invention in that it fails to particularly disclose any semiconductor memory devices, however, Examiner takes Official Notice that this feature is notoriously well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to equivalently substitute the memory banks of Vizireanu et al with any well known semiconductor memory devices in order to provide higher quality, non-magnetic storage devices whose elements are formed as solid state electronic components on an integrated circuit.

13. Assuming Applicant's newly amended feature does not raise the issue of new matter, claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vizireanu et al in view of Schaus et al for the same reasons as set forth in Sections 11 and 12 above.

Response to Arguments

14. Applicant's arguments filed 3/31/00 have been fully considered but they are not persuasive.

With respect to Applicant's argument on page 4 of the Remarks that element 340 of Vizireanu is not a processor, it is submitted that according to Webster's II New Riverside University Dictionary, a "processor" is defined as "a program that translates another program into a form acceptable to the computer being used." Therefore, element 340 fully meets such

definition because it translates the audio programs from the memory banks into a form acceptable to the computer 320 being used.

Conclusion

15. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-6306 or 308-6296

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ping W. Lee whose telephone number is (703) 305-4865.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PING W LEE
PRIMARY EXAMINER
GROUP 2700

pwl
April 21, 2000